

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant	McCallister	<u>REQUEST FOR REHEARING UNDER 37 C.F.R. § 41.52</u>
Appeal No.	2009-014375	
Serial No.	10/718,505	
Filing Date	11/20/2003	
Group Art Unit	2611	
Examiner Name	Jean B Corrielus	
Confirmation No.	1245	
Attorney Docket No.	125.136USR1	
Title: CONSTRAINED-ENVELOPE TRANSMITTER AND METHOD THEREFOR		

Commissioner for Patents
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Appellant requests rehearing of the original decision of the board dated March 18, 2010. Appellant respectfully asserts that the Board misapprehended various aspects of the arguments regarding whether May teaches a delay. Further, when these arguments are given their proper consideration, the Board should reverse the Examiner's holding that claims 2-5, 8-11, 13-16, 18 and 20 are anticipated by May.

In its decision, the Board found that there was "ample evidence that a delay is inherent in May." Board Decision, at p. 10. The Board committed at least three errors in reaching this conclusion.

I. McCallister's testimony regarding the May reference cannot be given any weight

First, the Board states that because McCallister is a party, his statements that May inherently teaches a delay are an admission. Further, the Board indicated that "[h]aving made this admission, Appellant[] cannot now assert that these features are not

taught by the prior art.” *Id.* Appellant respectfully asserts that this finding is contrary to the well-established doctrine of assignor estoppel.

The Federal Circuit has explained that:

Assignor estoppel is an equitable doctrine that prevents one who has assigned the rights to a patent (or patent application) from later contending that what was assigned is a nullity. . . . Courts frequently mention four justifications for the doctrine of assignor estoppel: “(1) to prevent unfairness and injustice; (2) to prevent one [from] benefiting from his own wrong; (3) [to adopt the] analogy [of]. . . estoppel by deed in real estate; and (4) [to adopt the] analogy to a landlord-tenant relationship.” (quoting *Hal Cooper, Estoppel to Challenge Patent Validity: The Case of Private Good Faith vs. Public Policy*, 18 Case W. Res. 1122, 1128 (1967)).

Diamond Scientific Co. v. Ambico, Inc., 848 F.2d 1220, 1224 (Fed. Cir. 1988).

The facts of this case demonstrate the justifications spelled out by the Federal Circuit in *Ambico*. See, Appeal Brief at pp. 11-13. Mr. McCallister sold his invention for valuable consideration. Now, in fear of this reissue patent being asserted against him, Mr. McCallister is attempting to attack the validity of the claims in this reissue proceeding. If Mr. McCallister is prevented from attacking the patent in another forum, e.g., in litigation under assignor estoppel, why should Mr. McCallister be able to attack the patent application in this forum? His duty under Rule 1.56 has been satisfied by Appellant making *May* of record. Mr. McCallister has no duty to convince an Examiner that the art anticipates or renders the claims obvious. In fact, under the Doctrine of Assignor Estoppel, he is prevented from doing just that.

Therefore, Appellant respectfully asserts that the Board incorrectly gave weight to Mr. McCallister’s submission in adopting Finding of Fact number 1. Appellant further requests that the Board withdraw this Finding of Fact.

II. Birch’s Testimony has been misapprehended by the Board

The Board further reached its decision in part because “Birch also states that May teaches a delay.” The Board cited to Finding of Fact number 3 to support this conclusion. Board Decision, at p. 10. Appellant respectfully asserts that this is a mischaracterization of Mr. Birch’s testimony. Birch’s complete testimony is as follows:

7. *May* does not disclose how to delay “the input signal,” as described in [Mr. McCallister’s] submission.

8. *May* also does not disclose how to delay “the input signal . . . by at least half of the pulse-shape duration,” as described in [Mr. McCallister’s] submission.

10. *May* does not disclose how to time-align the scaled bandlimited pulse-shape “so that the pulse peak and the signal peak are time-coincident,” as described in [Mr. McCallister’s] submission.

11. The delay in *May* to make “the pulse peak and the signal peak . . . time-coincident” would be a variable delay.

12. The delay in *May* to delay “the input signal . . . by at least half of the pulse –shape duration” would be a variable delay.

13. It is my opinion that one of ordinary skill in the art would not be able to devise a variable delay circuit to make “the pulse peak and the signal peak . . . time-coincident” in *May* without undue experimentation.

14. It is my opinion that one of ordinary skill in the art would not be able to delay “the input signal . . . by at least half of the pulse-shape duration” under the variable signal conditions of *May* without undue experimentation.

Birch I, at ¶¶7-14 (emphasis added). When read in context, it is clear that Birch testified that one of ordinary skill in the art would not find anything in *May* about delay. *See*, Birch I at ¶7. While Birch does say what kind of delay *May* would require, Birch does not testify that delay is taught in *May*. The statements about delay in *May* (paragraphs 11 and 12) are based on Mr. Birch’s understanding of the present invention and Mr. Birch’s knowledge as an expert. It is not based on what is taught in *May* and it is not based on what one of ordinary skill in the art would understand as inherent in *May*. These statements fall far short of justifying the conclusion drawn by the Board from Finding of Fact number 3 that: “the declaration of Birch also states that *May* teaches a delay.” Board Decision, at p. 10.

Appellant respectfully requests that the Board withdraw Finding of Fact number 3. And, further, Appellant requests that the Board withdraw the statement in the decision that “Birch also states that *May* teaches a delay.”

III. The Evidence of record provides the showing, if any, required by *In re Wands*

The Board found that “Appellant[] [has] not made a showing which applies the *Wands* factors” with respect to Birch’s assertion that May is non-enabling as to the delay feature. Appellant respectfully asserts that this finding is against the weight of the evidence.

In *In re Wands*, the Federal Circuit set the standard for testing whether a disclosure satisfies the enablement requirement. Specifically, the court listed a number of factors, including:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). When applied to this case, Appellant respectfully asserts that many of these factors demonstrate that May does not enable the delay feature. First, the May reference does not provide any direction on the using a delay element. Birch I, at ¶¶ 7, 8, and 10. Further, there are no working examples in May of a delay function. *Id.* Further, McCallister’s declaration submitted on July 5, 2005 further demonstrates the lack of direction given by May regarding the use of a delay. Mr. McCallister, in his explanation of May, adds substantially to the teachings of this relatively brief reference. Further, as noted in the Appeal Brief at page 9, Mr. McCallister is not one of ordinary skill in the art. Appellant respectfully asserts that Mr. McCallister’s superior skill and knowledge allowed him to see his invention through the holes in May. Therefore, based on the evidence of record, Appellant has demonstrated that May does not enable the claimed delay limitation.

Conclusion

Based on the foregoing, Appellant requests that the Board reconsider its decision and remand this case and instruct the Examiner to enter a notice of allowance for claims 2-5, 8-11, 13-16, 18 and 20 because:

- (1) McCallister's testimony is barred by the doctrine of assignor estoppel,
- (2) Birch did not testify that May teaches a delay, and
- (3) the Wands factors support the conclusion that May does not teach the use of a delay.

If necessary, please charge any additional fees or credit overpayments to Deposit Account No. 502432.

Respectfully submitted,

Date: May 18, 2010

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